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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,181	09/14/2000	Richard J. McCurdy	L10389	2443

7590 10/18/2004

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EXAMINER

CHEN, BRET P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/662,181

Applicant(s)

MCCURDY ET AL.

Examiner

B. Chen

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-42, 44, 47-55 and 87-102 is/are pending in the application.
- 4a) Of the above claim(s) 87-99 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42 and 44 is/are allowed.
- 6) ☒ Claim(s) 33-41, 47-55 and 100-102 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1762

DETAILED ACTION

Claims 33-42, 44, 47-55, 87-102 are pending in this application which is an RCE of Serial Number 09/662,181, which is a CON of Serial Number 09/199,539 now abandoned; which is a CON of Serial Number 08/696,203, now abandoned. Amended claims 37, 42, 51; canceled claims 56-86; and newly added claims 100-102 are noted.

The amendment dated 7/30/04 has been entered and carefully considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-42, 44, 47-55, and 100-102 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 33 line 10, the term "in the crystalline phase" is deemed new matter. The same issue applies to claims 35, 41, 47, 49, 51, 55 and newly added claims 100-102.

In claim 33 line 10, the term "photocatalytically-activated self-cleaning coating" is deemed new matter. The same issue applies to claims 35, 37, 40, 47, 49, 51, 54, 55 and newly added claims 100-102.

Art Unit: 1762

In claim 47, the limitation "said coating has a photocatalytically-activated self-cleaning reaction rate of at least about 8.1×10^{-3} to $9.1 \times 10^{-3} \text{ cm}^{-1} \text{ min}^{-1}$ " is deemed new matter. The same issue applies to claim 49, 51, 55 and newly added claims 100-102.

Allowable Subject Matter

Claims 42 and 44 are allowed.

Response to Arguments

Applicant's arguments filed 7/30/04 have been fully considered but they are not persuasive. It should be noted that pp.18-19 discuss dimensionally stable and pp.19-23 address claim 42. In view of the amendment, the rejection over "dimensionally stable" has been withdrawn and claim 42 has now been allowed.

Applicant makes the following arguments with respect to the other new matter rejections and relies on the Third McCurdy Declaration for support. The Third McCurdy Declaration is summarized as follows:

- 1) paragraphs 5-6 address the self-cleaning aspect
- 2) paragraph 7 address the photocatalytic activity aspect
- 3) paragraph 8 address the reaction rate aspect.

It is noted that the applicant's claims as presently written are not commensurate in scope with the examples set forth in the third McCurdy Declaration. Hence, the applicant has not established that the parameters recited necessarily result in the claimed properties. This line of argument has been previously addressed in prior office action and is not repeated here.

Art Unit: 1762

In addition, applicant has again requested the examiner to provoke an interference (p.14).
The examiner will not stipulate at the present time.

Applicant's arguments have been considered but are not deemed persuasive.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Chen whose telephone number is (571) 272-1417. The examiner can normally be reached on 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bc - 10/11/04


BRET CHEN
PRIMARY EXAMINER